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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,017

08/01/2006

Teiko Sutoh

30162/41537

4672

4743

7590

03/19/2009

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EXAMINER

MCKANE, ELIZABETH L.

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

03/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,017

Applicant(s)

SUTOH ET AL.

Examiner

ELIZABETH L. MCKANE

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 3, 7, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel (WO 00/61200) in view of Chujo et al. (US 5,441,561).

Patel teaches a plasma sterilization indicator including an adsorption indicator (page 9, lines 5-9) and an organic metal compound (page 12, lines 10-26). In use, an article is placed within a container to which is affixed the indicator. See page 3, lines 21-23 and lines 29-34; page 4, lines 33-34. Patel is silent with respect to the incorporation of a polyvalent alcohol in the indicator but does teach that 'alcohols' are suitable additives to aqueous ink compositions (page 16, lines 1-2) and that the inks can be 'solvent based' (page 16, lines 19-20). Chujo et al. teaches that water-soluble organic solvents are well-known in aqueous ink compositions. Polyols such as ethylene-, diethylene-, polyethylene-, and propylene-glycol are the preferred organic solvents. See col.3, lines 35-56. It would have been obvious to one of ordinary skill in the art to add a water-soluble polyol as the 'alcohol' of Patel, since Chujo et al. evidences their common use in ink compositions. The results of using a known polyol solvent in the ink formulation of Patel would have been readily apparent and expected.

Patel further discloses that the adsorption indicator may be hematoxylin (page 10, line 23), eriochrome black T (page 10, line 17), or pyridazo naphthol (page 11, line

14) and that the organic metal compound may be an aluminum chelate compound (aluminum acetylacetonate). See page 12, line 31. It is well-within the purview of one of ordinary skill in the art to choose from the indicators and activators disclosed by Patel to achieve the desired outcome, depending upon the chosen sterilant for the plasma, as well as the humidity, temperature, and time for sterilization.

Response to Arguments

3. Applicant's arguments filed 8 January 2009 have been fully considered but they are not persuasive.
4. On page 4 of the Response, Applicant notes that 'no basis for rejection of claim 2' was stated in the office action. However, although claim 2 failed to be enumerated in numbered paragraph 5 of the office action, the limitations of claim 2 were clearly addressed in this paragraph.
5. On page 5 of the Response, Applicant argues that in contrast to the present invention, the problem to be solved in Chujo is to obtain highly precise images. Applicant also notes that the alcohols in Patel are merely taught as a general additive. In response, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The Examiner further maintains that the use of a known and common solvent in the ink formulation of Patel would have been obvious to one of ordinary skill in the art, in the absence of unexpected results. Patel

discloses the use of alcohols and solvents in the formulation and thus, the use of such in Patel would have been obvious in view of Chujo.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ELIZABETH L. MCKANE** whose telephone number is (571)272-1275. The examiner can normally be reached on Mon-Fri; 5:30 a.m. - 2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth L McKane/
Primary Examiner, Art Unit 1797

elm
15 March 2009